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10/780,313	02/17/2004	Daniel Opperman	G08.072/U	1068

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EXAMINER	
ALI, HATEM M	

ART UNIT	PAPER NUMBER
3692	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/780,313	OPPERMAN ET AL.	
	Examiner	Art Unit	
	HATEM ALI	3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 April 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *20-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *20-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. The following is a **Final Action** on merit in response to a communication received on **4/10/09.**

Acknowledgement

2. Claim Status **:**

- Claims **amended : 20 -21**

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 20-23 remain rejected under 35 U.S.C. § **101** based on Supreme Court precedent, and recent Federal Circuit decisions, a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. FLook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876). The process steps in **claims (20-23)** are not tied to another statutory class nor do they execute a transformation. Thus, they are non-statutory.

See Response to argument.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-19 (Cancelled)

Claims 20 - 23 are rejected under 35 U.S.C. 103 (a) as being unpatentable over ***Himmelstein*** (2002/0038278) in views of ***Russo*** (2004/068458).

As per claim 20, ***Himmelstein*** discloses a method comprising:

displaying on a display screen of a computer a first order type menu at times when a first order destination alternative is selected from an order destination menu (**Fig.1;** via display screen of computers and **para 0050-052**; via barter website **106** or pull down menus **507** and also **para 0147;** via inherently destination at NYSE and the NASDAQ market) the first order destination alternative representing a first order destination, the first order type menu listing only order type alternatives that represent order types supported by the first order destination**;** and

displaying on said display screen of said computer a second order type menu at times when a second order destination alternative is selected from the order destination menu, second order destination alternative representing a second order destination, the second order type menu listing only order type alternatives that represent order types supported by the second order destination, the second order type menu being

different from the first order type menu (**para 0052**, lines 12; via an array of pull down menus **507** for selection of second order type menu different from first type);

Himmelstein fails explicitly to disclose that the first order destination and the second order destination are each selected from the group consisting of (a) securities exchange, (b) a market maker,(c) an ECN, and (d) a trading market placer; and order type alternatives included in both said and second order type menus include a market order type and a limit order type.

However, ***Russo*** being in the same field of invention discloses that the first order destination and the second order destination are each selected from the group consisting of (a) securities exchange, (b) a market maker,(c) an ECN, and (d) a trading market placer; and order type alternatives included in both said and second order type menus include a market order type and a limit order type (**Abstract** and **Figs 1-108** , para **0001-0003** - via viewing screen window with user's of the machine's interface; para **0010** - via a logic field- provision of two choices; **para 0240**-via choosing another symbol of exchange [**Fig-057**] as destination ; **para 0233** and **0241** – via a limit order trade [type] and trade per share price [market order type] respectively).

Therefore, it would have been obvious to an ordinary skill in the art at the time of invention was made to modify the disclosure of ***Himmelstein*** and include the features mentioned by ***Russo*** to facilitate the user of the **machine-1** Dissemination Center then immediately signals ... The user ... of **NYSE** listed **CMGI** stock ... wait for the profits and or ships to come in (**para-0234**)

As per claim 21, *Himmelstein* discloses a method comprising:

displaying on a display screen of a computer a first order destination menu at times when a first financial instrument trading symbol is displayed in an order input area of a user interface (**Fig.1** and **para 0050-0052**; via barter website **106** or pull down menus **507** and also **para 00147** inherently destination at NYSE and the NASDAQ market. First instrument trading symbol **Aetna** Stock-**AET** at line 21 of para **0041**), the first order destination menu listing only order destination alternatives that correspond to order destinations that support trading in a first financial instrument that correspond to the first financial instrument trading symbol; and

displaying on said display screen of said computer a second order destination menu at times when a second financial instrument trading symbol is displayed in the order input area, second order destination alternative representing a second order destination, the second order type menu listing only order type alternatives that represent order types supported by the second odder destination, the second order type menu being different from the first order type menu, the second order destination menu being different from the first order destination men (**para 0052**, lines 12; via an array of pull down menus **507** for selection of second order type menu different from first type. Second Instrument trading Symbol - the DuPont Option **DD** also in **Fig.5A**).

Himmelstein fails explicitly to disclose that at least one of the order destination alternatives listed by the first order destination menu is different from each order destination alternative listed by the second order destination menu; and each of

the order destinations is selected from the group consisting of (a) a securities, (b) a market maker, (c) an ECN and (d) a trading market place.

However, ***Russo*** being in the same field of invention discloses that at least one of the order destination alternatives listed by the first order destination menu is different from each order destination alternative listed by the second order destination menu; and each of the order destinations is selected from the group consisting of (a) a securities, (b) a market maker, (c) an ECN and (d) a trading market place (**Abstract** and **Figs 1-108** , para **0001-0003** - via viewing screen window with user's of the machine's interface; **para 0010** - via a logic field- provision of two choices; **para 0240**-via choosing another symbol of exchange **[Fig-057]** as destination ; **para 0233** and **0241** – via a limit order trade [type] and trade per share price [market order type] respectively).

Therefore, it would have been obvious to an ordinary skill in the art at the time of invention was made to modify the disclosure of ***Himmelstein*** and to include the features mentioned by ***Russo*** to facilitate the user of the **machine-1** Dissemination Center then immediately signals ... The user ... of **NYSE** listed **CMGI** stock ... wait for the profits and or ships to come in (**para-0234**).

As per claim 22, *Himmelstein* discloses that the first financial instrument trading symbol represents a first common stock (**para 0041**, line 21; via **Aetna** Stock symbol-**AET, 234**); and the second financial instrument trading symbol represents a second common stock (**para 0041**, line 19; via **DuPont** Stock-**DD, 228).**

As per claim 23, *Himmelstein* discloses that the first financial instrument trading symbol represents a common stock **(para 0041** line 21; via **Aetna** Stock symbol-**AET, 234)**; and the second financial instrument trading symbol represents an option **(para 0051**, line 12; via the **DuPont** Option-**DD).**

Claims 24-37 (canceled)

Response to Arguments

5. In response to **Applicant's** Remarks on page 5, para 1-2, lines 1+ that "Claims **20-23** remain ... Claims **20** and **21** having been amended ... It is believed that the above –noted **claim amendments** have overcome this rejection, at least because clams **20** and **21** are now clearly tied to an apparatus, namely the display screen of a computer," **the examiner** does not agree, addition of the limitation "on a display screen of a computer" is insignificant and does not overcome the rejection. Therefore, the method claims remain rejected.

Claims 20-21 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to a machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v.

Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example **by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state**.

Here, applicant's method steps fail the first prong of the new Federal Circuit decision since they are not tied to a machine and can be performed without the use of a particular machine.

The mere recitation of the machine with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. Insignificant extra-solution activity will not transform an unpatentable principle into a patentable process (see John Love, Deputy Commissioner for Patent Examination Policy, memorandum Jan. 7, 2009).

Note the Board of Patent Appeals Informative Opinion Ex parte Langemyeret al-
http://iplaw.bna.com/iplw/5000/split_display.adp?fedfid=10988734&vname=ippqcases2&wsn=500826000&searchid=6198805&doctypeid=1&type=court&mode=doc&split=0&scm=5000&pg=0

6. **Applicant's** arguments filed on **4/10/09** have been fully considered but they are not persuasive.

As **Applicant** again refers and Remarks page 5, line 12 that "Examiner's completely ill-conceived Answer to Applicants' Appeal Brief", **the Examiner** respectfully put the same answers again as mentioned below:

1) In response to **applicant's** argument (**page 7**, last two lines) that "As far as appellants can determine, ***Himmelstein*** fails to disclose either order type menus or order destination menus as recited in the claims at issue herein", **The Examiner** refers ***Himmelstein*** disclosing clearly the order type menus (see **para 0049**, lines 1+) "the system **100** in its most generalized configuration permits barters of different securities, financial interests, ... Himmelstein Option".

In **para 0054, line 1+** "In the example of **Fig 5,** barter **website 106** is accessed via an online stock trading company ... In step **404**, the barterer selects from the displayed items in step **402.** In the embodiment of Fig**. 5A**, (**para 0051**, line 1+) a symbol **502** representing a selection ... the **DuPont Option DD** is depicted ... closing date".

In **para 0052**, line 4+ "Optionally, an alphabetical list of companies and /or stock symbols ... also displayed. The barter may enter the selected item **502** by typing ... name or symbol of the company, the barter ordering module locates the first listed item that matches the entered characters. Alternatively, the portfolio is deployed for selection

via an array of **PULL DOWN menus 507,** each displaying one class of the items of the barter's portfolio".

In **para 0053**, line 1+ "Once the barterer locates and selects the item to be traded", and "once the order **(para 0100**, line 1+) is submitted ... the matching engine searches website database" and in **para 0103**, lines 1+ "if the individual decides ... to barter away selected portfolio stock ... and when a posted order is chosen, the system **100** enters ... notify the individual of the transaction ..."shares trading away'" as reflected in screen table **620** of **Fig.6."**

2) In response to **applicant's** further arguments **(page 8**, first para) that "The Russo reference ...appear to be selecting a symbol that represents a particular security, and selecting between either a market order type or limit order type ... Reference lacks disclosure of any order destination menu as recited in the claims now being appealed", as a secondary reference ***Russo*** clearly discloses first and second order destinations and order type menus with the additional features to make it obvious in the reference. In **para 0219-0228** with **Figs. 039-060** , it is clear to get the steps of operation with window **4G** showing all order destination selections for **NYSE** (stock symbol **– CMGI**), **NASDAQ** (OXHP) & **AMEX (**ADVANA**) Exchanges**. Next **(para 0229**) "user" of the machine has three options, such as Monitoring, Limit order and Trading. So trading without limit order type – a market order trading (implied). Hence, it is clear with monitoring, then selection and trading in ***Russo's*** additional features mentioned in different steps of operations as **Menus** in Window **4G**.

3) In response to **appellant's** further arguments (**page 8**, second para) that, "the ***Russo*** reference does not explicitly show even one order type menu, but it appears ...it does not appear to teach the two different order type menus called for by claim 20", here **Russo** is referred again for his clear disclosures of limit or market order type menus (understood for sell, buy or hold transactions) in **Figs 61-84**, depicting specifically in **Fig. 073** (sell @ 17.00), **Fig.080** (buy [100] shares of **ADVNA**), **Fig 084** (Trading complete) and also more transactions in **Figs. 091-096.**

4) Finally, it is to be noted and understood that references, cited are to teach and suggest the concept of invention, but not the complete invention applied for.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HATEM ALI whose telephone number is (571)270-3021. The examiner can normally be reached on 8.00 to 6.00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on 571-272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Harish Dass
Primary Examiner

Hatem Ali
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